

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## D. Remarks

Rejection of Claims 1-13 and 15-18 Under 35 U.S.C. §103(a), based on Wittsche (U.S. Patent No. 6,556,975) in view of Dodd (U.S. Patent No. 6,633,849).

Applicant has assumed that the Office Action includes a typographical error, and that only claims 1-3, 5-10, 12-13 and 15-18 are being rejected based on the above combination of references. No grounds for rejection based solely on these two cited references have been presented for claims 4 and 11.

The rejection of claims 1-3 and 5-9 will first be addressed.

Applicant first notes that claim 1 has been amended to uniformly recite “member” in place of “user” and “person”. It is hoped this alleviates any difficulty encountered in determining the bounds of the claim.

The invention of claim 1 is directed to a franchise system for organizing and establishing a headquarter for business transactions over a network. The franchise system includes various components including at least one headquarter network server, a plurality of franchise store servers, and a plurality of member servers.

The at least one headquarter network server has a number of elements including merchandise information memory data, a home page creation system, a home page sending service, an order receiving system, a received data transfer system, and a franchise store ID system.

As is well established, to establish a prima facie case of obviousness, a rejection must meet three basic criteria. First, there must be some suggestion or motivation to modify a reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all claim limitations.

Applicant traverses the present rejection based on a number of grounds.

### A) **The Combination of References Does Not Show All Limitations of Claim 1**

The cited combination of references is not believed to show or suggest (1) a home page creation system, (2) a homepage sending service, or (3) an order receiving system.

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1) No “home page creation system” or “a homepage sending service”

Applicant’s claim 1 recites a home page creation system that creates a home page for each franchise store. In addition, the claim also recites a home page sending service that sends home page data for the home page of each franchise store to at least one predetermined member server.

Applicant does not believe the cited combination of references shows the above limitation.

To show a home page creation system, the rejection relies on the reference *Wittsche*.<sup>1</sup> However, *Wittsche* is directed to an on-line mall that presents a page for all stores in the mall. The reference never shows or suggests a server that provides a homepage for each individual store in the mall. All mentions of a “home page” set forth within *Wittsche* describe one homepage: that of the on-line mall, not any particular store within a community of the on-line mall:

The search engine, advertisements, browsing options, and gift registry options are show in the home page or initial page *of the on-line mall website*. (*Wittsche*, Col. 10, Lines 37-49, emphasis added).

If the customer selects step 810 the advertisement in FIG. 12A being displayed on the home page website *of the on-line mall*, then the specific merchandise displayed in the advertisement is displayed in step 836 in FIG. 12B. (*Wittsche*, Col. 10, Lines 37-49, emphasis added).

If upon entry into the on-line mall home page the customer selects to enter the gift registry in step 814 in FIG. 12A, the gift registry page is displayed in step 837 in FIG. 12B. (*Wittsche*, Col. 11, Lines 10-11, emphasis added).

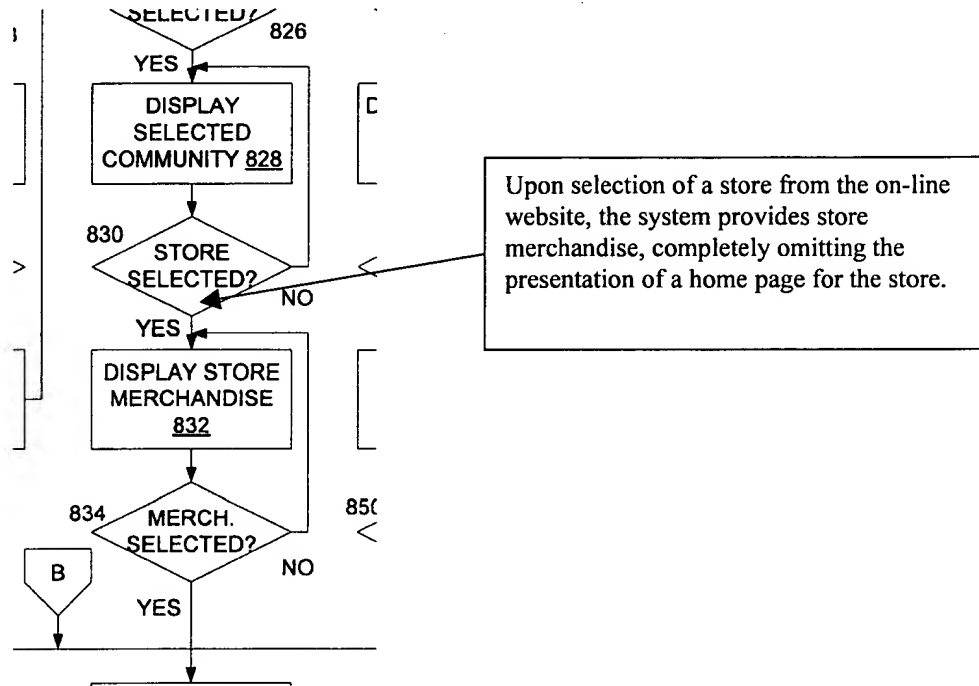
Thus, the discussion of home pages within the reference *Wittsche* are directed to a single home page for the entire on-line mall, and never to home pages for each store of the on-line mall.

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<sup>1</sup> See the Office Action, dated March 24, 2005, Page 2, Last partial paragraph, Page 3, Lines 3-7 and 11-13.

In fact, the reference is believed to teach away from the creation and sending of home pages for individual stores. FIG. 12B of *Wittsche* shows operations of the on-line mall when a customer selects a store. As shown, below, upon selection of the store, the store merchandise is displayed not any home page for the store:

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Therefore, because the cited reference only teaches the creation of a single home page for an on-line mall, the cited reference is not believed to show or suggest “a home page creation system that creates a home page for each franchise store” or a “home page sending service sends home page data for the home page of each franchise store to at least one predetermined member server”, as recited in claim 1.

## 2) No “order receiving system”

Applicant’s claim 1 also recites an order receiving system that “processes orders... through the home pages of each franchise store”.

As noted above, *Wittsche* does not disclose any franchise store home page. Accordingly, an order processing system like that of claim 1 cannot be shown by the reference.

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**B) No Motivation for the Proposed Modification of *Wittsche***

Applicant's invention, as recited in claim 1, is directed to a franchise system. That is, a system that combines a number of franchisors. As a result, the claim recites particular structures: franchise store servers and a franchise store ID system. The rejection acknowledges that the cited references do not show a franchise store arrangement, the rejection argues that such an arrangement is obvious. Applicant respectfully disagrees.

The sole rationale for finding a franchise system as obvious in light of an on-line mall is set forth below:

Wittsche does disclose communities... it would have been obvious to extend Wittsche with franchise in order to add another description of communities by the use of the word franchise... one of ordinary skill would have been motivated to extend Wittsche with franchise and thereby increase the potential additional parties in the community – with the mnemonic of franchisee and increased the potential applications of the system. (Office Action, dated 03/24/2005, Page 3, Lines 14-19).

Applicant notes that this rationale does not appear sufficient on its face to establish a prima facie case of obviousness. Suggestion/motivation for a proposed modification must have a factual basis:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art.<sup>2</sup>

The above rationale is not from either of the cited references. If the Examiner is relying on official notice, Applicant seasonably traverses such notice and requests a reference in support. Absent a sufficient factual basis for the proposed modification of *Wittsche*, the only apparent

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<sup>2</sup> *In re Jones*, F.2d 347 (Fed. Cir. 1992).

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motivation to incorporate the system of *Wittsche* into a franchisor arrangement would appear to be Applicant's Specification/invention. This would be the prohibited use of hindsight to reconstruct Applicant's invention.

For all of these reasons, this ground for rejection is traversed.

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### C) **Dependent Claims 2 and 5-9 Separately Patentable**

Various claims depending from claim 1 are believed to be separately patentable over the cited reference.

#### 10 1) **Claim 2 Separately Patentable**

Claim 2 recites that the "merchandise information memory data further includes information for goods not available at one of the franchise stores, but available at the headquarter".

Applicant respectfully requests clarification of this ground for rejection. Claim 2 was  
15 rejected under 35 U.S.C. 103(a). That is, the rejection has indicated that claim 2 is believed to be obvious in light of a combination of references. The examination guidelines regarding obviousness rejections are clear: all claim limitations must be shown or suggested, either explicitly or inherently. Further, in the case where it is argued that a limitation is inherently shown, the rejection should still cite those sections of the reference relied upon to show  
20 inherency.

The rejection does not appear to meet the above criteria. The rejection of claim 2 set forth in the present Office Action does not indicate that the limitations of claim 2 are shown in any reference, or generally available to one skilled in the art. In fact, the rejection has apparently not considered the limitations of claim 2, and indicates that the limitations of claim 2 have been  
25 given "little patentable weight" and considered to be "non-functional descriptive material".<sup>3</sup>

Accordingly, if claim 2 is being rejected based on 35 U.S.C. 103(a), a prima facie case of obviousness cannot have been established.

The rejection of claim 2 indicates that limitations of claim 2 have not been considered

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<sup>3</sup> See the Office Action, dated 03/24/2005, Page 7, Lines 1-10.

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pursuant to MPEP §2106.<sup>4</sup> However, this portion of the MPEP is not related to obviousness, but rather patentable subject matter – rejections based on a different statute: 35 U.S.C. 101. If claim 2 is being rejected for not being patentable subject matter, the proper statute has not been cited, and Applicant has not been given a fair opportunity to address such a rejection, by either argument or amendment.

Accordingly, because claim 2 has been rejected based on 35 U.S.C. 103(a), but the claim limitations have not been considered, a prima face case of obviousness of this claim has not been established.

**2) Claim 5 Separately Patentable**

Claim 5 is also believed to be separately patentable. Claim 5 recites that the “uniform resource locator values include a first portion unique to each franchise store and a second portion common to all franchise stores and the headquarters”.

To show the limitations of claim 5, the rejection relies on the following reasoning:

Regarding claim 5... Dodd teaches a franchise system, wherein the uniform resource locator value includes a first portion unique to each store and second portion common to all franchise stores and the headquarters (Col. 5, Lines 28-39) (See Office Action, dated 03/24/05, Page 7, Last partial paragraph).

*Dodd* teaches methods and systems for electronically forwarding an online gift. Applicant has reviewed the reference *Dodd* in detail, and found no reference to url values having common portions as argued by the rejection.

The cited paragraph of *Dodd*, set forth below, makes mention only of a recipient’s ID. However, such an ID is not related to any store, but rather identifies the recipient of a gift ordered according to *Dodd*.

In one embodiment, the recipient may be automatically associated with the appropriate gift order information due to an identifier associated with the recipient. In such a situation, the gift server node automatically determines it is the recipient who has

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<sup>4</sup> See the Office Action, dated 03/24/2005, Page 7, Line 10.

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connected to it from the recipient's network ID or recipient's IP address that is part of any message being sent from the recipient to the gift server node. Thus, in this embodiment, the identifier is any information (such as the recipient's network ID or IP address) that is automatically determinable by the gift server node to identify the recipient and match it with the appropriate gift order information. (*Dodd*, Col. 5, lines 28-39).

Examining the remainder of *Dodd* reveals the disclosure of one url. However, in sharp contrast to Applicant's claim, the teachings are directed to a single url:

In order to connect to the gift server node... In the exemplary embodiment, the user enters a conventional uniform resource location (URL), such as <http://www.bluerockave.com>. into the address field 115 in order to establish an electronic or online connection to the gift server node at that network address. One skilled in the art will realize that such a URL is used to interrogate nameservers on the network to determine the appropriate IP address associated with the gift server node. (*Dodd*, Col. 4, Lines 22-32).

Again, the above excerpt is believed to teach one url, not multiple urls having common portions, as recited in claim 5.

Accordingly, because the cited references do not appear to show all the limitations of claim 5, claim 5 is believed to be separately patentable.

**3) Claims 6-9 Separately Patentable**

Claims 6-9 are believed to be separately patentable for the same essential reason as claim 2. The limitations of claims 6-9 have not been considered in the obviousness rejection. Accordingly, a prima facie case of obviousness is not believed to have been established for these claims. If these claims are being rejected based on 35 U.S. C. 101, Applicant has not been afforded a fair opportunity to address such a rejection by either argument or amendment.

The rejection of claims 10 and 12-13 will now be addressed.

The invention of claim 10 is directed to an electronic franchise shopping system for a plurality of franchise stores. The system includes a plurality of franchise store servers and at

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least one headquarter network server. The at least one headquarter network server includes a goods master data base, a member entry data base, a franchise store data base, a home page data base, a home page creation system, a franchise store identification (ID) system, and an order system.

5 As in the case of claim 1, claim 10 has been amended to uniformly recite “member” in place of “user”, “person” and “buyer” in hopes of alleviating any difficulty encountered in determining the bounds of the claim.

The rejection of claim 10 is traversed based on a number of reasons.

10 **D) The Combination of References Does Not Show All Limitations of Claim 10**

The cited combination of references is not believed to show or suggest all the limitations of claim 10. In particular, the references are not believed to show or suggest: (1) a goods master database, (2) a home page creation system, or (3) an order system.

15 **1) No “goods master database”**

Applicant’s claim 10 recites a goods master data base that stores information for goods sold by the plurality of franchise stores, such goods including goods... not available at the particular franchise store but available at a headquarter.

To address this ground for rejection, Applicant incorporates by reference the same general  
20 comments set forth above in Section C)1) directed to claim 2. In particular, the rejection reasoning has not shown how such limitations are not present in the reference, and seems to impose a 35 USC 101 ground for rejection within a 35 USC 103 rejection.

**2) No “home page creation system”**

25 The home page creation system of claim 10 provides a home page for an accessing member according to unique web page data for the franchise store and goods information from the goods master data base. The home page is generated according to a predetermined data sent by the member from a remote user terminal.

To address this ground for rejection, Applicant incorporates by reference the same general  
30 comments set forth above in Section A)1). In particular, the reference *Wittsche* shows but one

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home page for an on-line mall, and not a home page with data unique to each store, as recited in claim 10.

### 3) No “order system”

The order system of claim 10 that receives orders through each home page for the franchise stores and transfers said order data from the at least one headquarter network server to the franchise server corresponding to the home page, the order data including at least a member identification and goods identification.

To address this ground for rejection, Applicant incorporates by reference the same general comments set forth above in Section A)2).

### E) No Motivation for the Proposed Modification of *Wittsche*

To the extent that the rejection of claim 10 relies on the modification of *Wittsche*, the comments of Section B) are incorporate herein.

### F) Dependent claim 13 Separately Patentable

Claim 13 recites that url data sent includes a first portion corresponding to the franchise and a second portion unique to each franchise store.

To address this ground for rejection, Applicant incorporates by reference the same general comments set forth above in Section C)2) directed to claim 5.

The rejection of claims 15-18 will now be addressed.

The invention of claim 15 is directed to an electronic franchise shopping system for a plurality of franchise stores that includes a least one headquarter server and a plurality of franchise servers, each corresponding to a different franchise store.

The at least one headquarter server has a number of elements including a goods master data base, a member entry data base, a franchise store data base, a home page data base, a franchise store ID system, a home page sending system, and an order processing system.

### G) The Combination of References Does Not Show All Limitations of Claim 15

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The cited combination of references does not show or suggest all the limitations of claim 1. In particular, the references do not show or suggest: (1) a home page sending system or (2) an order processing system.

5     **1)     No “home page sending service”**

Applicant’s home page sending service of claim 15 sends home page data according to a first type url and a plurality of second type urls. The first type url comprising a url common to the system. Each second type url corresponding to a different franchise store. The home page sending service also sending a home page for a franchise store.

10       To address this ground of rejection, Applicant incorporates by reference the comments set forth above in Section C)2), with respect to the url arrangement of claim 15 and A)1) with respect to the home page sending arrangement of claim 15.

**2)     No “order processing system”**

15       The order processing system of claim 15 receives orders from members through home pages each corresponding to a particular franchise store.

To address this ground for rejection, Applicant incorporates by reference the same general comments set forth above in Section A)2).

20     **H)     No Motivation for the Proposed Modification of *Wittsche***

To the extent that the rejection of claim 10 relies on the modification of *Wittsche*, the comments of Section B) are incorporate herein.

25     Rejection of Claims 4 and 11 Under 35 U.S.C. §103(a), based on *Wittsche* in view of *Dodd* and further in view of *Anuff et al.* (U.S. Patent No. 6,327,628).

The rejection of claim 4 will first be addressed.

To the extent that this ground for rejection relies on the combination of *Wittsche* in view of *Dodd*, the comments set forth above in Section A) are incorporated by reference herein.

30       The rejection of claim 11 will now be addressed.

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To the extent that this ground for rejection relies on the combination of *Wittsche* in view of *Dodd*, the comments set forth above in Section D) are incorporated by reference herein.

Rejection of Claim 14 Under 35 U.S.C. §103(a), based on *Wittsche* in view of *Dodd* and further in view of *Spagna et al.* (U.S. Patent No. 6,587,837).

To the extent that this ground for rejection relies on the combination of *Wittsche* in view of *Dodd*, the comments set forth above in Section D) are incorporated by reference herein.

Rejection of Claim 19 Under 35 U.S.C. §103(a), based on *Wittsche* in view of *Dodd* and further in view of *Allsop et al.* (U.S. Patent No. 5,970,472).

To the extent that this ground for rejection relies on the combination of *Wittsche* in view of *Dodd*, the comments set forth above in Section G) are incorporated by reference herein.

In addition, Claim 19 is believed to be separately patentable over the cited references for the following reasons.

Claim 19 recites that the home page sending system sends a unique home page for each second type url. Each such unique home page includes merchandise data for merchandise available at the franchise store, and merchandise not available at the franchise store but available at a headquarters location.

The rejection notes that *Wittsche* in view of *Dodd* does not specifically disclose and teach a home page sending system, as recited in claim 19, and relies on *Allsop et al.* to teach such limitations. However, Applicant believes *Allsop et al.* teaches away from Applicant's arrangement.

*Allsop et al.* shows a method for electronic commerce for manufacturers and authorized dealers. In the arrangement shown, multiple dealers can supply products produced by a manufacturer. In one disclosed routine, one manufacturer's website is utilized to fulfill a product order:

The manufacturer's computer is a Web server (Web site) which includes a conventional shopping basket application... the manufacturer's Web computer receives the billing information and determines whether the information is complete... Hence, the manufacturer actually processes the order and completes the sale, but does not fulfill the

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product order. (*Allsop et al.*, Col. 9, Line 35 to Col. 10, Line 3).

Thus, *Allsop et al.* teaches an arrangement in which orders are processed by a single manufacturer website and not by sites or pages of any of the authorized dealers.

5 In very sharp contrast, Applicant's independent claim 15 (from which claim 19 depends), recites an arrangement in which orders a processed, not through a headquarter home page, but rather the individual franchisor home pages:

10 [A]n order processing system that receives orders from members through home pages each corresponding to a particular franchise store, said orders including order data identifying a member and goods ordered. (Applicant's claim 15).

Thus, because *Allsop et al.* teaches the fulfillment of orders from a single centralized manufacturer website, the reference is not believed to teach away from the limitations of the claim, and thus not provide motivation for the proposed combination, or alternatively, rebut any  
15 prima facie case of obviousness.

For all of these reasons, this ground for rejection is traversed.

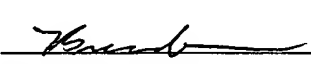
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Claims 1, 10, 15 and 17 have been amended, not in response to the cited art, but to reliable claim terms to assist in determining the bounds of Applicant's claims.

For all of the above reasons, the present claims 1-19 are believed to be in allowable form.

5 It is respectfully requested that the application be forwarded for allowance and issue.

Respectfully Submitted,

 17/25/05  
Bradley T. Sako  
Attorney  
Reg. No. 37,923

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Bradley T. Sako  
WALKER & SAKO, LLP  
300 South First Street  
Suite 235  
San Jose, CA 95113  
Tel. 1-408-289-5315

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